

No. 15115.

IN THE

**United States Court of Appeals
FOR THE NINTH CIRCUIT**

RALPH O. HUTCHENS,

Appellant,

vs.

LOUIS D. FAAS, BERNICE H. FAAS, LEONARD A. FAAS,
GENEVIEVE E. FAAS, Co-partners doing business as
KING O'LAWN MANUFACTURING CO.; WALTER FAAS,
RUDOLPH FAAS, M. W. ENGLEMAN, Assignee for Bene-
fit of Creditors for KING O'LAWN MANUFACTURING
CO., KING O'LAWN, INC., a California Corporation,

Appellees.

APPELLEES' BRIEF.

LYON & LYON,
JOHN B. YOUNG,

811 West Seventh Street,
Los Angeles 17, California,

Attorneys for Appellees.

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Co., KING O'LAWN, INC., a California Corporation,

Appellees.

APPELLEE'S BRIEF.

This is an appeal from the judgment of the District Court (Mathes, D. J.) dismissing plaintiff-appellant's complaint for infringement of United States Letters Patent No. 2,719,398.

The District Court's jurisdiction is based upon the patent laws of the United States, as alleged in the Second Amended Complaint and admitted in the Answer thereto, and more specifically upon 28 U. S. C., Sec. 1338(a). Title 28 U. S. C., Sec. 1291, gives this Court jurisdiction of this appeal.

Statement of the Case.

A. The Nature of the Controversy.

This is a suit for infringement of Letters Patent No. 2,719,398, granted October 4, 1955, to plaintiff-appellant, for "Lawn Trimmer."

B. The Parties.

Plaintiff-appellant is an individual, the patentee named in the patent in suit.

Defendants-appellees Louis D. Faas and Leonard A. Faas are brothers, and together with their wives, Bernice H. Faas and Genevieve E. Faas, respectively, are co-partners doing business as King O'Lawn Manufacturing Co. Walter Faas and Rudolph Faas are brothers of Louis D. Faas and Leonard A. Faas. At the time of the trial, M. W. Engleman was assignee for benefit of creditors for King O'Lawn Manufacturing Co. [Tr. 35, 65] but a reassignment to Louis D. Faas, Bernice H. Faas, Leonard A. Faas and Genevieve E. Faas was made subsequent to entry of Judgment in this cause on January 30, 1956. King O'Lawn, Inc., is a California corporation but has no assets nor liabilities and is completely inactive [Tr. 65].

C. The Pleadings.

The original complaint filed August 16, 1955, related only to an earlier patent No. 2,618,919. An amended complaint filed October 21, 1955, added a new patent, No. 2,719,398. The action was dismissed with prejudice as to the first patent No. 2,618,919 by Stipulation entered

December 28, 1955 [Tr. 46], and the Second Amended Complaint [Tr. 43] relating only to the patent No. 2,719,398 was filed concurrently with the Stipulation.

In the Stipulation of December 28, 1955 [Tr. 46], plaintiff admitted the sale and public use in the United States of a machine as shown in the first patent No. 2,618,919 during the year 1948, *i.e.*, more than one year prior to the effective filing date (June 16, 1950) of the patent in suit, No. 2,719,398.

D. Disposition of the Case by the Court.

After a trial upon the merits, the District Court held that the claims of the patent in suit are not infringed and cannot be interpreted broadly enough to be infringed by the accused devices without also causing them to read on plaintiff's prior art machine described in the Stipulation of December 28, 1955 [Tr. 67, 68]. The District Court did not rule on the issue of validity of the patent in suit, in view of its holding of non-infringement [Tr. 68].

E. The Subject Matter of the Patent in Suit.

The patent discloses a lawn trimmer and edger driven by a small gasoline engine. The device is not used to mow a lawn, but only to trim the edges. *A single supporting wheel is used.* This enables the operator to grasp the handle to tilt the machine either fore and aft or from side to side, or in any other direction about the central supporting wheel. A cutting blade is belt-driven from the engine and this blade may be operated vertically or horizontally or at inclined positions.

Summary of Argument.

I.

The claims at issue in the patent in suit read squarely on plaintiff's 1948 prior art machine described in the Stipulation of December 28, 1955.

II.

The claims in issue in the patent in suit cannot be interpreted broadly enough to be infringed by the accused devices without also causing them to read on the prior art machines set out in said Stipulation.

III.

Plaintiff's 1948 machine described in the said Stipulation is prior art, with respect to the patent in suit.

IV.

The accused devices do not infringe any claim in the patent in suit and defendants have not admitted infringement.

V.

If the Court of Appeals should reverse the District Court's Judgment of non-infringement, the Court of Appeals should not remand the case for a determination of the issue of validity, but should rule on this issue directly, because the evidence of invalidity is physical and documentary in form and is before the Court of Appeals for consideration.

ARGUMENT.

Point I.

The claims at issue in the patent in suit read squarely on Plaintiff's 1948 prior art machine described in the Stipulation entered December 28, 1955. The manner in which each of the claims at issue in the patent in suit read on that prior art machine is shown in detail in Defendant's Physical Exhibit "C" now before this Court. For convenience a copy of the fourth sheet of this exhibit relating to Claim 16 is attached to this brief. Plaintiff's 1948 prior art machine renders the patent in suit totally void, providing that the claims of the patent read on that machine. It is defendants-appellees' contention that all of the claims at issue including Claim 16, relied upon by plaintiff-appellant read squarely and without equivocation upon that machine.

On the issue of prior public use and sale there is no distinction between use or sale by another and by the inventor himself. (*Schmeiser v. Thomasian*, 227 F. 2d 875 (9th Cir., 1955).)

The United States Patent Office had no knowledge prior to issuing the patent in suit of the public sale and use of plaintiff's 1948 machine; the file history of the patent [Pltf. Ex. 1] fails to mention it.

Point II.

The claims in issue in the patent in suit cannot be interpreted broadly enough to be infringed by the accused devices without also causing them to read on plaintiff's

1948 prior art machine. The manner in which the claims at issue in the patent in suit read upon that machine is shown in Defendants' Physical Exhibit "C" now before this Court. The claims at issue also read upon the Boggs device (as distinguished from the Boggs patent) set forth in the same Stipulation and shown on a drawing attached thereto. The claims at issue cannot be read on the accused devices for the reasons pointed out in the Conclusions of Law of the District Court entered January 30, 1956 [Tr. 67]. The claims at issue do not cover the accused devices because the claims require that the "wheel means" itself permit angular adjustment of the base. While this is true of plaintiff's machine having only a single supporting wheel, it is not true of defendants' machines wherein the tilting of the base is accomplished not by the wheels but by a leverage system acting on one of the three wheels.

Point III.

Plaintiff's 1948 machine described in the Stipulation entered December 28, 1955, is prior art with respect to the patent in suit. An erroneous statement appears at the top of page 7 of the Brief for Appellant, as follows:

"(e) The Court erred in considering the machine, Defendants' Exhibit 'B,' a prior art machine, for the patent application disclosing and claiming same was filed by plaintiff and was co-pending in the United States Patent Office with his patent application on which the patent in suit was granted."

Said Exhibit "B" is the 1948 machine of the Stipulation of December 28, 1955, and the Stipulation not only settles the fact that the machine was sold and in public use in

the United States in 1948 but the Stipulation also includes an agreement that the effective filing date of the patent in suit is June 16, 1950. The co-pendency of the earlier patent application resulting in the first patent No. 2,618,919, is therefore absolutely immaterial.

On January 16, 1950, plaintiff Ralph O. Hutchens filed application Serial No. 168,506, and on March 29, 1954, filed a continuation application Serial No. 419,916. The latter application issued on October 4, 1955, as Patent No. 2,719,398, now in suit. Not only was it stipulated that the effective filing date of the patent in suit was June 16, 1950, but a consideration of the new patent law effective January 1, 1953, Sections 101, 102, 112, 120 (see appendix) leads to the inevitable conclusion that the effective filing date of the patent in suit cannot be carried back of June 16, 1950, because the patent does not mention the earlier Hutchens patent No. 2,618,919; under Section 120 of the codified law the filing date of the earlier patent cannot be claimed. Hence, Section 102(b) applies and the patent is invalid if the claims thereof cover a device which was in public use or sale in this country more than one year prior to June 16, 1950.

Point IV.

Defendants have not admitted infringement of any claim of the patent in suit.

It appears that the principal argument presented in the Brief for Appellant is that defendants are alleged to admit infringement at least of Claim 16. This "admission" is alleged to be found in a consideration of the Request for Admission of Facts Nos. 5, 6, 7, 8 and 11 [Tr. 5-7, and 37-38]. Careful examination, however,

shows that no such admission was made. No. 5 asks if the accused devices contain

“an engine-supporting base mounted on wheels which base can be angularly adjusted relative to the surface on which said wheels rest.”

Defendants admitted that the accused devices contain such construction but this is *not* the same as admitting that the accused devices embody the language of the claims. Thus, Claim 16 requires

“wheel means that movably support said base for angular adjustment thereof relative to the surface on which said wheel means rests.”

Defendants admit that the accused structure has a base which can be angularly adjusted, but do *not* admit that the wheel means movably support the base for such adjustment. The adjustment in the accused devices is obtained by a leverage or linkage system and not by the wheel means.

Point V.

If the Court of Appeals should reverse the District Court's judgment of non-infringement, the Court of Appeals should not remand the case for determination of the issue of validity but should rule on this issue directly, because the evidence of invalidity is physical and documentary in form and is before the Court of Appeals for consideration. No oral testimony is involved and therefore the demeanor of witnesses and appraisal of inferences to be drawn from their testimony is not involved here. Since this is an appeal in equity, the whole case is before

the Court of Appeals and it should decide the case, so far as it is in a condition to be decided, upon its merits. (*Waterloo Min. Co. v. Doe et al.* 82 Fed. 45 (C. C. A. 9).) Appeals in equity are heard *de novo* and disposed of finally without requiring that the case be remanded for further trial except in exceptional cases. (*Unkle v. Wills*, 281 Fed. 29, 34 (C. C. A. 8).) In *Edwards v. Lain*, 112 F. 2d 343 (C. C. A. 7, 1940), it was stated:

“In equity, an appeal brings up the whole record and appellate court may review the evidence and make such order or decree as the court of first instance ought to have made, giving proper weight to findings on disputed issues of fact which should be accorded to a tribunal which heard the witnesses.”

In *Ry-Lock Company, Ltd. v. Sears, Roebuck & Co.*, 227 F. 2d 615 (9 Cir., decided Nov. 21, 1955, Cert. Den., 100 L. Ed. Advance P. 353, the District Court held a patent void on the ground of anticipation by earlier patents. However, on appeal this Court reversed the lower court judgment, and said, at page 617:

“We note therefore that the findings of the trial court with respect to anticipation were based solely upon these paper patents unsupported by any testimony of witnesses in open court. It follows that we are in as good a position as was the trial court to consider and evaluate the anticipatory effect of the patents brought forward by Sears.”

This Court then went on to find that the patent was infringed, although no finding on the issue of infringement had been made by the lower court.

In *Martin v. Be-Ge Mfg. Co., et al.*, 232 F. 2d 530 (C. C. A. 9), decided April 19, 1956, Judge Mathes, sitting on the Court of Appeals for the Ninth Circuit said, at page 532:

“The Supreme Court has admonished that even in cases where no infringement appears, it is the ‘better practice’ to adjudicate also the issue of validity, *Sinclair & Carroll Co. v. Interchemical Corp.*, 1945, 325 U. S. 327, 330, 65 S. Ct. 1143, 89 L. Ed. 1644; but this has been interpreted as ‘a mere cautionary admonition to the courts to exercise their discretion whether to pass upon the question of validity, and to strike down clearly invalid patents where it would be in the public interest to do so, even though a finding of non-infringement would dispose of the case.’” (*Kemart Corp. v. Printing Arts Research Laboratories, Inc.*, 201 F. 2d 624, 634 (9 Cir., 1953); see *Harries v. Air King Products*, 183 F. 2d 158, 161-162 (2 Cir., 1950).

“Inasmuch as the patent in suit was issued in 1935 and expired in 1952, 35 U. S. C. §154, there remained no public interest in a determination of the issue of validity. So it was not necessary for the District Court to adjudicate that issue in view of the finding of non-infringement.”

In the present case the patent in suit issued October 4, 1955 and hence less than one year of its seventeen-year life has expired at this time. It is submitted that the public interest is best served by striking it down at the outset, if this Court of Appeals finds it to be invalid.

Claims 6-10, 15 and 16 in issue read squarely upon the following prior art not considered by the Patent Office:

- A. Plaintiff’s 1948 prior art machine shown and described in the Stipulation of December 28, 1955

[Tr. 46] and shown by Defendants' physical Exhibit "B".

- B. The Boggs machine (as distinguished from the Boggs patent) referred to in the same Stipulation [Tr. 45].
- C. The Knight patent No. 2,274,902 [see Defendant's physical Exhibit "C"].

Conclusion.

The Court of Appeals should sustain the judgment of non-infringement of the District Court. However, if the Court of Appeals should reverse on that point, it should hold the patent to be invalid as unpatentable over the prior art.

Respectfully submitted,

LYON & LYON,

By JOHN B. YOUNG,

Attorneys for Appellees.

APPENDIX.

Section 4 of the Act of July 19, 1952, c. 950, 66 Stat. 815, reads as follows:

“(a) This Act (this title) shall *take effect on January 1, 1953* and shall apply to all applications for patent filed on or after such date and to all patents granted on such applications. It shall apply to further proceedings on applications pending on such date and to patents granted on such applications except as otherwise provided. It shall apply to unexpired patents granted prior to such date except as otherwise provided.” (Emphasis added.)

Pertinent sections of the new codified law, Title 35, United States Code, are set out below:

#101. Inventions Patentable.

“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”

#102. Conditions for patentability: novelty and loss of right to patent.

“*A person shall be entitled to a patent unless—*

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) *the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or * * **” (Emphasis added.)

#112. *Specification.*

“The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. * * *”

#120. *Benefit of earlier filing date in the United States.*

“An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application *and if it contains or is amended to contain a specific reference to the earlier filed application.*” (Emphasis added.)